

MAR 23 2004

OFFICIAL

# Pepper Hamilton LLP

Attorneys at Law

One Mellon Bank Center  
500 Grant Street  
Pittsburgh, PA 15219-2502  
412-454-5023  
Fax 412.281.0717  
www.pepperlaw.com

## I. FAX INFORMATION SHEET

Date: March 23, 2004  
ID Number: 61297  
Identifier: 126433.110

Recipient Company: TC1600  
USPTO

Recipient's General Number: 571-272-1600

Recipient's Fax Number(s): 703-872-9306

Sender: Raymond A. Miller, Reg. No. 42,891  
Sender's Direct Line: 412-454-5813  
Sender's Email Address: millerr@pepperlaw.com

**RETURN FAX TO  
K. PUJOL**

Total Pages Including Cover: 23

Re: Application No. 09/904,744

Comments: Attached is the Amendment and Response to Office Action, Petition for Extension of Time and Certificate of Facsimile

An original or a copy has ☐ or has not ☒ been sent to you by mail ☐ or by overnight service ☐ or by email ☐.

◆ ◆ If transmission is not received, please call the sender ◆ ◆

◆ ◆ Confidentiality Note ◆ ◆

The documents accompanying this facsimile transmission contain information from the law firm of Pepper Hamilton LLP which is confidential and/or legally privileged. The information is intended only for the use of the individual or entity named on this transmission sheet. If you are not the intended recipient, you are hereby notified that any disclosure, copying, distribution or the taking of any action in reliance on the contents of this faxed information is strictly prohibited, and that the documents should be returned to this Firm immediately. In this regard, if you have received this facsimile in error, please notify us by telephone immediately so that we can arrange for the return of the original documents to us at no cost to you.

### 1. Operator's Use Only

Start Time: : am [ ] pm [ ]

2. End Time: :  
am [ ] pm [ ]

Operator:

PTO/SB/17 (10-03)  
Approved for use through 07/31/2008. OMB 0651-0032  
U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE  
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

# FEE TRANSMITTAL for FY 2004

Effective 10/01/2003. Patent fees are subject to annual revision.

☒ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT

(\$ 210.00

## Complete if Known

Application Number 09/904,744  
Filing Date July 13, 2001  
First Named Inventor Barbera-Guillem  
Examiner Name Sisson  
Art Unit 1634  
Attorney Docket No. 126433.110

## METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None

☒ Deposit Account:

Deposit Account Number 50-0436  
Deposit Account Name Pepper Hamilton LLP

The Director is authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☒ Credit any overpayments

☒ Charge any additional fee(s) or any underpayment of fee(s)

☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

## FEE CALCULATION

### 1. BASIC FILING FEE

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description	Fee Paid
1001 770	2001 385	Utility filing fee	
1002 340	2002 170	Design filing fee	
1003 530	2003 265	Plant filing fee	
1004 770	2004 385	Reissue filing fee	
1005 160	2006 60	Provisional filing fee	
SUBTOTAL (1) (\$)			

### 2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims	Extra Claims	Fee from below	Fee Paid
Independent Claims	-20** =	X	
Multiple Dependent	-3** =	X	

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description
1202 18	2202 9	Claims in excess of 20
1201 86	2201 43	Independent claims in excess of 3
1203 290	2203 145	Multiple dependent claim, if not paid
1204 86	2204 43	** Reissue independent claims over original patent
1205 16	2205 9	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2)

(\$ 0

\*for number previously paid, if greater; For Reissues, see above

## FEE CALCULATION (continued)

### 3. ADDITIONAL FEES

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description	Fee Paid
1051 130	2051 65	Surcharge - late filing fee or oath	
1052 50	2052 25	Surcharge - late provisional filing fee or cover sheet	
1053 130	1053 130	Non-English specification	
1812 2,520	1812 2,520	For filing a request for ex parte reexamination	
1804 820*	1804 820*	Requesting publication of SIR prior to Examiner action	
1805 1,840*	1805 1,840*	Requesting publication of SIR after Examiner action	
1251 110	2251 55	Extension for reply within first month	
1252 420	2252 210	Extension for reply within second month	
1253 950	2253 475	Extension for reply within third month	
1254 1,480	2254 740	Extension for reply within fourth month	
1255 2,010	2255 1,005	Extension for reply within fifth month	
1401 330	2401 165	Notice of Appeal	
1402 330	2402 165	Filing a brief in support of an appeal	
1403 280	2403 145	Request for oral hearing	
1451 1,510	1451 1,510	Petition to institute a public use proceeding	
1452 110	2452 55	Petition to revive - unavoidable	
1453 1,330	2453 665	Petition to revive - unintentional	
1601 1,330	2501 665	Utility issue fee (or reissue)	
1502 480	2502 240	Design issue fee	
1503 640	2503 320	Plant issue fee	
1460 130	1480 130	Petitions to the Commissioner	
1807 50	1807 50	Processing fee under 37 CFR 1.17(q)	
1806 180	1806 180	Submission of Information Disclosure Stmt	
8021 40	8021 40	Recording each patent assignment per property (times number of properties)	
1808 770	2808 385	Filing a submission after final rejection (37 CFR 1.129(a))	
1810 770	2810 385	For each additional invention to be examined (37 CFR 1.129(b))	
1801 770	2801 385	Request for Continued Examination (RCE)	
1802 900	1802 900	Request for expedited examination of a design application	

Other fee (specify)

\*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$ 210.00

## SUBMITTED BY

Name (Print/Type) Raymond A. Miller Registration No. 42,891 Telephone 412.454.5000  
Signature [Signature] Date March 23, 2004

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

This collection of information is required by 37 CFR 1.17 and 1.27. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS.  
SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

RECEIVED  
CENTRAL FAX CENTER

MAR 23 2004

OFFICIAL

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of : Emilio Barbera-Guillem  
Application No. : 09/904,744  
Group Art Unit : 1634  
Examiner : Sisson, Bradley L.  
Filing Date : July 13, 2001

For: POLYNUCLEOTIDE STRANDS OPERABLY LINKED TO NANOCRYSTALS  
FUNCTIONALIZED TO BE WATER SOLUBLE

Box Non-Fee Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA. 22313-1450

**AMENDMENT AND RESPONSE TO OFFICE ACTION UNDER 37 C.F.R. §1.111**

Dear Sir:

This Response and enclosed remarks are in response to the Office Action, dated October 23, 2003 issued in connection with the above-identified application. Applicant has also filed a Petition for a 2 month Extension of Time and have included authorization to charge the appropriate fee to Deposit Account 50-0436 as set forth under §1.17(a). Accordingly this response is timely filed. The Commissioner is authorized to charge or credit Deposit Account Number 50-0436 any deficiency or overpayment of fees necessary for this extension.

**Amendments to the Specification** begin on page 3 of this paper.

**Amendments to the Claims** begin on page 4 of this paper

**Remarks and Arguments** begin on page 7 of this paper.